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EXAMINER

MATZ, DANIEL R

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/809,109

Applicant(s)

SHIMAMURA, KAORU

Examiner

Daniel Matz

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In both lines 1 and 2, claim 6 recites the limitation "data is data." This term is not defined by the claim, the specification does not provide a standard for ascertaining the meaning of the term, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 7-8, 11- 13, 16-17, and 20-26, are rejected under 35 U.S.C. 102(b) as being anticipated by International Patent Application WO 98/21713 by Leville et al.

**Regarding claim 1**, Leville et al. disclose a system for selling goods (a merchandising system) through a computer network (fig. 1), the goods being a variety of elements which are different from each other and are sold one by one,

the system comprising:

Art Unit: 3641

a unit storage section (host computer, 10) storing a unit of the variety of elements according to the number of the elements and ranges to each of which a unit is applied (page 7, lines 18-21, storage of information on each product);

a detecting section (20) detecting the number of elements to be purchased on the basis of information of one or more elements to be purchased which is received from a purchaser (page 10, lines 8-9);

a reading section (10) reading at least one unit applied to the element to be purchased on the basis of the number of element detected from the unit storage section (page 8, lines 25-27, transaction data is sent to and "read" by the host computer);

a first calculating section (10) calculating the number of elements belonging to a range to which the read at least one unit is applied;

and a second calculating section (20) calculating the purchase price by using the read at least one unit and the number of elements calculated (page 10, lines 8-9).

**Regarding claim 2,** Leville et al. disclose a system further comprising:

a purchase record storage section (10) storing the number of elements purchased by the purchaser in the past (page 7, lines 21-22, storage of past shopping history);

and an addition section (10) reading the number of elements purchased in the past from the purchase record storage section when the number of elements is detected by the detecting section, and adding the read number to the detected number, wherein the reading section reads at least one unit applied to the element to be purchased from the unit storage section by using a result of addition by the addition section (page 7,

Art Unit: 3641

lines 12-25, the computer (10) analysis "adds" the elements purchased in the past to the elements to be purchased to determine the price to be offered).

**Regarding claim 7**, Leville et al. disclose a system for a purchaser to purchase goods through a network, the goods being a variety of elements which are different from each other and are sold one by one, the system comprising:

a transmitting section (17) transmitting information of one or more elements to be purchased to a seller;

a receiving section (17) receiving a price of the element to be purchased, which is calculated by using at least one unit of an element determined on the basis of the number of elements to be purchased and a range to which the unit is applied;

and a display controlling section (17) displaying the received price onto a display.

**Regarding claim 8**, Leville et al. disclose a system wherein the receiving section (17) receives a price of the element to be purchased, which is calculated by using at least one unit of an element determined on the basis of a result of addition between the number of elements to be purchased and the number of elements purchased in the past by the purchaser.

**Regarding claim 11**, Leville et al. disclose a goods selling system having a client (17) and a server (10) connected to the client through a network (fig. 1), the goods being a variety of elements which are different from each other and are sold one by one, the client comprising:

a transmitting/receiving section (17) transmitting information of one or more elements to be purchased;

Art Unit: 3641

and a display controlling section (17) displaying a received purchase price onto a display, the purchase price being received by the transmitting/ receiving section from the server (10) as a price of the element to be purchased, and the server comprising:

a unit storage section (10) storing units of the variety of elements in accordance with the number of elements;

a second transmitting/receiving section (10) receiving information of the element and transmitting the purchase price;

a detecting section (10) detecting the number of elements to be purchased on the basis of the information of the element;

a reading section (10) reading at least one unit applied to the element to be purchased on the basis of the detected number of element(s) from the unit storage section;

a first calculating section (10) calculating the number of elements belonging to a range to which the read at least one unit is applied;

and a second calculating section (20) calculating the purchase price by using the read at least one unit and the number of calculated element(s).

**Regarding claim 12**, Leville et al. inherently disclose a computer readable medium on which a program for allowing a computer (10) to execute a process of selling goods through a network is recorded, the goods being a variety of elements which are different from each other and are sold one by one, the program comprising:

a step of storing a unit of the variety of elements according to the number of the elements a step of detecting the number of elements to be purchased on the basis of

Art Unit: 3641

information of one or more elements to be purchased which is received from a purchaser;

a reading step of reading at least one unit applied to the element to be purchased on the basis of the number of element detected; a step of calculating the number of elements belonging to a range to which the at least one read unit is applied;

and a step of calculating the purchase price by using the read at least one unit and the number of elements calculated. Note that in order for the computer (10) to perform these steps, the computer must execute program steps, which must be encoded on computer readable medium in order for the computer to be able to read and execute the program.

As to limitations that are considered to be inherent in a reference, note the case law of In re Ludtke, 169 USPQ 563, In re Swinehart, 169 USPQ 226, In re Fitzgerald, 205 USPQ 594, In re Best et al., 195 USPQ 430, and In re Brown, 173 USPQ 685, 688.

**Regarding claim 13**, Leville et al. inherently disclose a computer readable medium wherein the program further comprises:

a step of storing the number of elements purchased by the purchaser in the past;  
a step of reading the number of elements purchased in the past when the number of elements is detected, and adding the read number to the detected number;

and a step of reading at least one unit applied to the element to be purchased by using a result of the addition from the unit storage section. Note that in order for the computer (10) to perform these steps, the computer must execute program steps, which must be encoded on computer readable medium in order for the computer to be able to read and execute the program.

**Regarding claim 16**, Leville et al. inherently disclose a computer readable medium in which a program for allowing a computer (10) to execute a process for a purchaser to purchase goods through a network is recorded, the goods being a variety of elements which are different from each other and are sold one by one, the program comprising:

a step of transmitting information of one or more elements to be purchased to a seller;

a step of receiving a price of the element to be purchased, which is calculated by using at least one unit of an element determined on the basis of the number of elements to be purchased and a range to which the unit is applied;

and a step of displaying the received price onto a display. Note that in order for the computer (10) to perform these steps, the computer must execute program steps, which must be encoded on computer readable medium in order for the computer to be able to read and execute the program.

**Regarding claim 17**, Leville et al. inherently disclose a computer readable medium wherein the program further comprises:

a step of receiving a price of the element to be purchased, which is calculated by using at least one unit of an element determined on the basis a result of addition between the number of elements to be purchased and the number of elements purchased in the past by the purchaser and a range to which the unit is applied.

**Regarding claim 20**, Leville et al. disclose a system for selling goods through a network (fig. 1), comprising:

a storage section (10) storing a goods purchase record of a purchaser;



Art Unit: 3641

and a calculating section (10) calculating a purchase price of goods to be purchased which is received from the purchaser on the basis of the purchase record of the purchaser stored in the storage section.

**Regarding claim 21**, Leville et al. disclose a system (fig. 1) wherein the calculating section calculates the purchase price of the goods to be purchased on the basis of a quantity of goods in the purchase record and a quantity of the goods to be purchased.

**Regarding claim 22**, Leville et al. disclose a system (fig. 1) further comprising:  
a unit storage section (10) storing units of the variety of goods according to the quantity of goods and a range to which each unit is applied, and wherein the calculating section calculates the purchase price of the goods to be purchased by obtaining the application range to which the goods to be purchased belongs and the quantity of the goods to be purchased on the basis of a sum of a quantity of goods in the purchase record and the quantity of goods to be purchased.

**Regarding claim 23**, Leville et al. disclose a system for selling goods through a network, comprising:

a transmitting section (17) transmitting information of goods to be purchased which is designated by a purchaser to a seller;

a receiving section (17) receiving a purchase price of the goods to be purchased, which is determined on the basis of a purchase record of the purchaser in the past;

and a display controlling section (17) displaying the received price onto a display.

**Regarding claim 24**, Leville et al. disclose a goods selling system (fig. 1) having a client and a server connected to the client through a network, the client comprising:

Art Unit: 3641

a transmitting section (17) transmitting information of goods to be purchased which is designated by a purchaser to the server;

a receiving section (10) receiving a purchase price of the goods to be purchased from the server;

and a display controlling section (17) displaying the received price onto a display, and the server comprising:

a purchase record storage section (10) storing a goods purchase record of the purchaser;

and a calculating section (10) calculating a purchase price of the goods to be purchased, which is received from the client on the basis of the purchase record of the purchaser stored in the purchase record storage section.

**Regarding claim 25**, Leville et al. inherently disclose a computer readable medium on which a program for allowing a computer (10) to execute a process for selling goods through a network is recorded, the program comprising:

a step of identifying a purchaser of goods (purchaser registers at kiosk);

a step of obtaining a goods purchase record of the purchaser (stored on server 10);

and a step of calculating a purchase price of goods to be purchased which is received from the purchaser on the basis of the purchase record (discount price provided to purchaser).

**Regarding claim 26**, Leville et al. disclose a method for selling goods through a network (fig. 1) , comprising:

identifying a purchaser of goods (purchaser registers);

Art Unit: 3641

obtaining a goods purchase record of the purchaser (stored on server 10);  
and calculating a purchase price of goods to be purchased which is received from the purchaser on the basis of the purchase record (discount price provided to purchaser).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-6, 9-10, 14-15, and 18-19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Leville et al. as applied to claims 1-2, 7-8, 11- 13, and 16-17, above, in view of USPN 5,137,379 granted to Ukai et al.

**Regarding claims 3, 5, 6 (as best understood), 9, 14, and 18,** Leville et al. disclose a system (fig. 1) that further comprises: a data storage section (10) storing a set of the data;

a creating section (10) creating a supply file including data corresponding to information of the elements to be purchased by using the set of data stored in the data storage section;

and a supplying section (17) supplying the created supply file to the purchaser. Leville et al. do not disclose a system wherein the "goods" denotes a set of data as the elements. Ukai et al. teach a printer wherein a set of data (stored in a ROM cartridge) is used to provide added font sets for the printer (font set data) and are sold as goods to

Art Unit: 3641

allow a consumer to upgrade the performance of the printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the system of Leville et al. to produce a system wherein the "goods" to be sold denotes a set of data as the elements to be sold; for example, font set data to upgrade a printer.

**Regarding claims 4, 10, 15, and 19**, Leville et al. disclose a system wherein the receiving section (10) receives a supply file further including information on past purchases by the purchaser.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. USPN 4,826,332 discloses a printer with a cartridge for storing font set data.
- b. USPN 6,108,100 discloses a printer with RAM and ROM.
- c. USPN 6,014,634 discloses a system and method for providing incentives (price discounts) through a computer network.
- d. USPN 5,933,811 discloses a system and method for delivering customized advertisements based on a purchaser's past purchases.
- e. USPN 6,055,573 discloses a system that tracks consumer purchase history and delivers targeted advertising.
- f. The article by Docters (ref. U) discusses discount price strategies, including volume discounts.
- g. The article by Weng (ref. V) discussed quantity discounts.

Art Unit: 3641


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Matz whose telephone number is (703) 306-4164. The examiner can normally be reached on Mon-Thurs, alt Fri 7:30am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (703) 306-4198. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4180.

DM

June 4, 2003

  
MICHAEL CARONE  
SUPERVISORY PATENT EXAMINER